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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/921,051

08/02/2001

Andrew Bell

1980044B-DIV

8076

28862

7590

07/28/2004

HUDAK, SHUNK & FARINE, CO., L.P.A.  
2020 FRONT STREET  
SUITE 307  
CUYAHOGA FALLS, OH 44221

EXAMINER

RABAGO, ROBERTO

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,051

Applicant(s)

BELL ET AL.

Examiner

Roberto Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-43 and 45-79 is/are pending in the application.
- 4a) Of the above claim(s) 60-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-42, 45-51, 55-58, 78 and 79 is/are rejected.
- 7) ☒ Claim(s) 43, 52-54 and 59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/2/2004 has been entered.

2. Rejection under 35 USC 103 over Johnson '556 in view of amendment.

Rejection of claims 35, 36 and 43 under 35 USC 112(2) is withdrawn in view of amendment. Applicants have avoided this rejection by deleting the term "hydrocarbyl" from parent claim 33, thereby broadening the scope of substituent R'. Accordingly, claims 33, 34, 37-40 and 42, previously indicated as potentially allowable, are newly rejected over Suld '338 as set forth below because these claims have been broadened regarding substituent R'.

### ***Claim Rejections - 35 USC § 102***

3. Claims 78, 33, 34, 37-40, 42, 56 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Suld et al. (US 4,100,338).

The reference shows in the first three working examples a method comprising a first step of combining NBD with a nickel dihalide complex comprising two trialkylphosphine ligands, wherein the two-component composition was held without the addition of any other components for several minutes. Accordingly, the reference contains all claimed limitations. Regarding claim 58, the required presence of at least a trivial amount (0.25%) of another polycycloolefin monomer would inherently be met by contaminating quantities of other monomers such as NB, dimers, isomers of NB or NBD and similar compounds which would necessarily be present in the reference NBD monomer solution because the reference has stated that such components may be present in the NBD used (col. 2, lines 11-14).

***Claim Rejections - 35 USC § 103***

4. Claims 78, 79, 33-42, 45-51 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (US 5,629,398).

The reference teaches the polymerization of cyclic olefins in the presence of at least a transition metal complex and a cocatalyst. Although the reference has not presented a working example including all of the claimed components, each is suggested for use in the method as follows. Monomers including an extensive list of norbornadienes are disclosed col. 12, lines 37-65; transition metal complexes which include nickel and palladium are disclosed at col. 7, line 65 through col. 8, line 25; cocatalyst salts are disclosed at col. 8, line 38 through col. 10, line 52. Regarding the manner in which the catalyst components are combined, the reference states that each

component can be combined with monomer prior to the polymerization (col. 12, lines 5-7). Accordingly, one of ordinary skill in the art would be motivated to use the claimed method because the reference has disclosed using the claimed monomers, transition metal complexes and activator salts in a polymerization method, and has further stated that each of the transition metal complex and activator components may be added to the monomer prior to polymerization.

***Allowable Subject Matter***

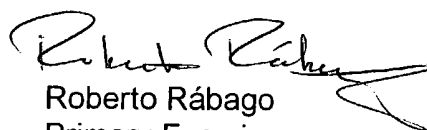
5. Claims 43, 52-54 and 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art cited on this record has not disclosed or reasonably suggested these particular species of the claimed composition.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roberto Rábago  
Primary Examiner  
Art Unit 1713

RR

July 22, 2004